REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claim 1 has been amended merely to correct an antecedent basis error. Claims 1-6, 8-21, 37-41, 43-54, 70-72, 74, 75, and 77 are pending in this application.

I.   Examiner Interview

Applicant wishes to thank the Examiner for the courtesy of the interview conducted September 17, 2009.

II.   Claim Rejections Under 35 U.S.C. § 102(e)

On page 2 of the Office Action, Claims 1-6, 8-21, 37-54, 70-72, 74-75, and 77 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,343,329 to Sharp (*Sharp*). Applicant respectfully points out that Claim 42 was canceled in the RCE filed December 11, 2008. Applicant also respectfully points out that no basis for rejecting Claims 71, 75, or 78 has been provided. Applicant further respectfully submits that *Sharp* fails to teach, suggest, or disclose all of the elements of at least independent Claims 1, 37, 70, 71, and 78, and dependent Claims 6, 12-21, 41, 47-54, 72, 74, 75, and 77.

A.   *Claims 1, 37, 70, 71, and 78*

Independent Claim 1 recites:

> storing a storage element in a computerized vending machine;
>
> receiving a first selection associated with an electronic item through an input interface of the computerized vending machine;
>
> electronically receiving a second selection associated with a physical item through the input interface of the computerized vending machine, wherein the physical item includes the storage element;
>
> storing the electronic item in the storage element of the physical item in response to the received first selection and the received second selection; and
>
> the computerized vending machine providing the physical item, wherein the electronic item is accessible from the physical item.

(Underlining added). Independent Claim 37 recites in part:

> receiving a first selection associated with an electronic item;
>
> <u>receiving a second selection associated with a physical item,</u> wherein the physical item includes a storage element;
>
> storing the electronic item in the storage element of the physical item in response to the received first selection and the received second selection; and
>
> <u>providing the physical item,</u> wherein the electronic item is accessible from the physical item.

(Underlining added). Independent Claims 70, 71, and 78, though of different scope, recite similar features.

On pages 3-5 of the Office Action, the Examiner states:

> Regarding Claim 1, Sharp discloses storing a storage element item in a computerized vending machine see Fig. 1 item 103,104,105;
>
> ...;
>
> electronically receiving a second selection associated with a physical item through the input interface of the computerized vending machine, wherein the physical item includes a storage element see Col 10 Ln 6-14;
>
> storing the electronic item in the storage element of the physical item in response to the received first selection and the received second selection see Col 10 Ln 18-26; and
>
> the computerized vending machine providing the physical item wherein the electronic item is accessible from the physical item see Fig. 5.
>
> ...
>
> Regarding Claim 37, 70, Sharp discloses ...
>
> ...;
>
> receiving of a second selection associated with a physical entity item, wherein the physical item includes a storage element see Col 10 Ln 6-10;
>
> storing the electronic item in the storage element of the physical item in response to the received first selection and the received second selection see Col 10 Ln 18-26 ; and

providing the physical item wherein the electronic item is accessible from the physical item see Fig. 5.

Again, the Examiner provides no basis for rejecting independent Claims 71 or 78. Applicant respectfully disagrees with the Examiner's characterization of *Sharp*. *Sharp* fails to disclose all of the elements of Claims 1, 37, 70, 71, and 78 when properly read in context with the remaining claim elements.

The Examiner cites to elements 103, 104, and 105 as providing a teaching for "storing a storage element item in a computerized vending machine." *Sharp* states:

> Software ATM 100 further includes a <u>volatile main memory</u>
> <u>103</u> comprised of volatile random access memory (RAM) for
> <u>storing the digital information and instructions coupled with</u>
> <u>bus 101</u>, and a <u>non-volatile read only (ROM) memory 104</u> (e.g.,
> read only memory, programmable ROM, flash memory,
> EPROM, EEPROM, etc.) coupled with bus 101 for <u>storing</u>
> <u>static information and instructions for processor 101</u>. Software
> ATM 100 also includes a <u>data storage device 105</u> (e.g., a
> magnetic drive, optical drive, tape drive, or the like) coupled
> with the <u>bus 101 for storing vast amounts of information</u>. It
> should be understood that the software programs being
> dispensed by software ATM 100 can be stored either in volatile
> memory 103, non volatile memory 104, data storage device
> 105, or in an external storage device (not shown)

(Col. 7, ll. 5-19; underlining added). Thus, the storage devices cited by the Examiner provide the information and instructions for operating the software ATM. Therefore, the elements 103, 104, and 105 cannot be included in the physical item provided by the computerized vending machine. As a result, *Sharp* fails to teach, suggest, or describe "storing a storage element in a computerized vending machine" as recited in Claim 1.

The Examiner cites to Column 10, lines 6-14 as providing a teaching for "electronically receiving a second selection associated with a physical item through the input interface of the computerized vending machine." Column 10, lines 6-14 of *Sharp* state:

> If the user is satisfied with the operation of the selected
> application program and decides to purchase or to rent the
> selected application program or content, the user may exit the
> test mode by pressing, for example, button 240, wirelessly via
> PDA 210, or by interacting with touch screen display 110.

The Examiner cites to Column 10, lines 18-26 as providing a teaching for "storing the electronic item in the storage element of the physical item in response to the received first selection and the received second selection." Column 10, lines 18-26 of *Sharp* state:

> Once purchased, <u>the selected application program can be downloaded</u> into PDA 210, either via contacts from cradle 220, via a wireless communication link (e.g., via a Bluetooth, Infrared, or other wireless link). Furthermore, <u>the software or content can be downloaded onto removable storage media inserted into removable storage slot 117</u>. The removable media can then be inserted into PDA 210 and the software or content can then be downloaded into PDA 210.

(Underlining added). Thus, *Sharp* describes an ATM to which a user can connect their PDA and from which the user can select software or other electronic content for download onto the connected PDA. As an alternative, the user can insert a removable storage media into the ATM and select software or other electronic content for download onto the inserted removable storage media. The only selection made by the user is the content to be downloaded which is consistently described as "software titles, content, or software services" (col. 9, ll. 15-16) that can be purchased or rented.

As described in paragraph [0029] of the specification, examples of a physical item which can be selected include:

> For example, in various embodiments the user could be able to employ a provided GUI and/or the like to learn of the various form factors available for PEs [physical items] (step 105). Accordingly the user might, for instance, be presented with text, pictures, information, and/or the like corresponding to the available form factors. As alluded to above, such forms could include, for example, include dolls, figurines, stickers, business cards, toys, temporary tattoos, nail treatments, postcards, phone straps, jewelry, balls, sports novelties, clothing (e.g., shirts, pants, jackets, hats socks, skirts, shoes, dresses, and/or the like, images, food containers, tickets (e.g., movie tickets, a theater tickets, a concert tickets, a transportation tickets, and/or the like), and/or the like.

Sharp fails to even consider the possibility of "receiving a second selection associated with a physical item through the input interface of the computerized vending machine." Therefore, Sharp fails to teach, suggest, or describe "electronically receiving a second <u>selection</u> associated with a physical item through the input interface of the computerized

vending machine, wherein the physical item includes the storage element" as recited in Claim 1, and similarly recited in Claims 37, 70, 71, and 78. The only physical items described in *Sharp* are a PDA or a removable storage media and both are provided by the user and manually connected to the software ATM by the user.

The Examiner cites to Fig. 5 reproduced below as providing a teaching for "providing the physical item."
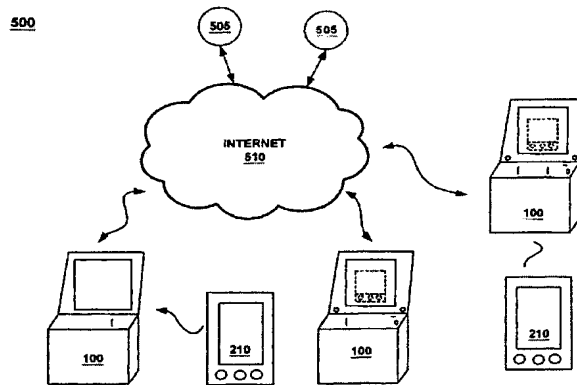

Fig. 5, however, merely shows the user provided PDA 210 and the various embodiments of the software ATM 100 to which a plurality of PDAs can be connected. Relative to Fig. 5, *Sharp* states:

> An <u>owner of PDA 210</u>, who wishes to purchase or rent a
> <u>computer software program or other content</u>, can use any one of
> software ATMs 100 on the network to access an application
> program stored in any other software ATM 100 or an
> application program stored in one of the networked servers 505
> as previously described.

(Col. 11, ll. 25-30; underlining added). Thus, again, the software ATM does not provide the PDA, the user provides the PDA (or removable storage media) and connects the PDA to the software ATM. Therefore, *Sharp* fails to teach, suggest, or describe "the computerized vending machine providing the physical item, wherein the electronic item is accessible from the physical item" as recited in Claim 1, and similarly recited in Claims 37, 70, 71, and 78.

On pages 2-3 of the Office Action, the Examiner further states:

> The Examiner interprets the limitation "providing the physical
> item" is equivalent to returning to a normal state after download
> and during the process of download the device is inactive, i.e.
> not capable of functioning, not "providing" service fro [sic] the
> user.

First, Sharp does not state that the device is inactive during the download. In fact, Sharp states:

> All displays and user interaction are accomplished using PDA 210 which wirelessly communicates the user selections to software ATM 100. Payment can be made using credit card information stored on PDA 210, E-wallet, a gift certificate stored on PDA 210, etc.

(Col. 9, ll. 48-50). Therefore, the PDA remains active during the download so that the user can make selections and payments. Second Applicant fails to understand how even if the PDA is inactive during the download and cannot provide a service to the user, this relates to "providing the physical item."

For at least these reasons, Applicant respectfully submits that *Sharp* fails to teach, suggest, or describe all of the elements of Claims 1, 37, 70, 71, and 78. Claims 2-6, 8-21, 38-54, 72, 74-75, and 77 depend from one of Claims 1, 37, 70, and 71. Therefore, Applicant respectfully requests withdrawal of the rejection of Claims 1-6, 8-21, 37-54, 70-72, 74-75, and 78.

B.   *Claim 70*

Claim 70 additionally recites the element of a "physical entity provisioning hardware." As discussed above, *Sharp* fails to disclose "the computerized vending machine providing the physical item." *Sharp* discloses only that a software ATM provides downloadable software and content to a user provided storage media. As a result, *Sharp* fails to disclose "physical entity provisioning hardware" as recited in Claim 70. Therefore, Applicant respectfully requests withdrawal of the rejection of Claim 70 and Claim 75, which depends from Claim 70, for at least this additional reason.

C.   *Claims 6 and 41*

Claims 6 and 41 additionally recite "wherein said storage element is a radio frequency identification tag." In rejecting Claims 6 and 41 on page 4 of the Office Action, the Examiner states "[r]egarding Claim 2-11, 20-21, 38-46, 54, Sharp discloses the virtual entity being a service provided through RFID through a remote station see Col 10 Ln 55-59." At column 10, lines 55-59 cited by the Examiner, *Sharp* states:

> The user may wish to get a report of the status of XYZ stock.
> The user can establish communications (e.g., via cradle,

Bluetooth, IR, etc.) with software ATM 100 and get the report
displayed either on their device or on the software ATM 100.

Sharp, however, fails to mention "a radio frequency identification tag" or use of "a radio frequency identification tag" as a storage element. Therefore, *Sharp* fails to disclose all of the elements recited in Claims 6 and 41. As a result, Applicant respectfully requests withdrawal of the rejection of Claims 6 and 41 for at least this additional reason.

D.   *Claims 12-19 and 47-54*

On page 4 of the Office Action, the Examiner states that "[r]egarding Claim 12-19, 47-53, Sharp discloses the physical entity taking many forms including rings, watches, jewelry and cards see Col 9 Ln 43-52." Column 9, lines 41-52 of *Sharp* state:

> In another embodiment, software ATM 100 may have no user
> interaction devices ... at all. This allows vendors to locate
> software ATM 100 away from public view if so desired. In one
> embodiment, a user can be made aware of the presence of
> software ATM 100 using the Bluetooth discovery process if the
> user's PDA is configured for this. All displays and user
> interaction are accomplished using PDA 210 which wirelessly
> communicates the user selections to software ATM 100.
> Payment can be made using credit card information stored on
> PDA 210, E-wallet, a gift certificate stored on PDA 210, etc.

Thus, column 9, lines 41-52 of *Sharp* fail to disclose any physical entity whatsoever corresponding to the "physical item" or "physical entity" recited in Claims 12-18 and 47-53. Applicant sees no basis for the Examiner's assertion. *Sharp* merely discloses that payment may be made with credit card information from the PDA, an E-wallet, or a gift certificate.

Claims 19 and 54 additionally recite "wherein access restrictions are imposed for said electronic item." The Examiner provides no indication of where *Sharp* provides any such teaching. In fact, *Sharp* fails to provide any such teaching.

For at least these additional reasons, Applicant respectfully submits that *Sharp* fails to teach, suggest, or describe all of the elements of Claims 12-19 and 47-54. Therefore, Applicant respectfully requests withdrawal of the rejection of Claims 12-19 and 47-54 for at least these additional reasons.

E. *Claims 20 and 21*

Claim 20 additionally recites "receiving payment for said physical item." Claim 21 additionally recites "wherein there is a correlation between payment amount and access restrictions imposed for said electronic item." In rejecting Claims 20 and 21 on page 4 of the Office Action, the Examiner states "[r]egarding Claim 2-11, 20-21, 38-46, 54, Sharp discloses the virtual entity being a service provided through RFID through a remote station see Col 10 Ln 55-59." At column 10, lines 55-59 cited by the Examiner, *Sharp* states:

> The user may wish to get a report of the status of XYZ stock.
> The user can establish communications (e.g., via cradle,
> Bluetooth, IR, etc.) with software ATM 100 and get the report
> displayed either on their device or on the software ATM 100.

Thus, the cited portion of *Sharp* provides no such teaching. *Sharp*, in fact, only indicates payment for the software downloaded and not for the physical item which is not even provided by the software ATM. *Sharp*, further fails to provide any teaching of "a correlation between payment amount and access restrictions imposed for said electronic item" as recited in Claim 21. Therefore, *Sharp* fails to disclose all of the elements of Claims 20 and 21. As a result, Applicant respectfully requests withdrawal of the rejection of Claims 20 and 21 for at least this additional reason.

F. *Claims 72, 74, 75, and 77*

Claims 72, 74, 75, and 77 additionally recite "receiving a third selection of one or more physical entity cosmetic attributes, wherein the physical item is provided with said cosmetic attributes." In rejecting Claims 72, 74, and 77 on page 5 of the Office Action, the Examiner states "[r]egarding Claim 72, 74, 77, Sharp discloses the receiving specifications of one or more physical entity cosmetic attributes see Col 13 Ln 59-65." At column 13, lines 59-65 cited by the Examiner, *Sharp* states:

> The present invention optionally allows a user of portable
> computer devices to emulate a version of their portable
> computer on the display of the software ATM and to test a
> given computer software program on the emulator. The user
> can purchase the computer program if satisfied with the test
> result and download the program directly into their portable
> computer.

The cited portion of *Sharp*, and in fact *Sharp* in its entirety, fails to provide any teaching whatsoever related to "receiving a third selection of one or more physical entity cosmetic

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attributes, wherein the physical item is provided with said cosmetic attributes" as recited in Claims 72, 74, 75, and 77. Therefore, *Sharp* further fails to disclose all of the elements of Claims 72, 74, 75, and 77. As a result, Applicant respectfully requests withdrawal of the rejection of Claims 72, 74, 75, and 77 for at least this additional reason.

Applicant believes that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date   September 18, 2009   By _____

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